

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-29 remain in this application. Claim 30 has been added.

Claims 1-15, 17-18, 20, and 23-29 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over Croy (U.S. 6,040,829) and Wakai (U.S. 5,973,722). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a system with "a plurality of contactless transceivers that allow a data transfer at close range with private portable terminals within the vehicle" wherein "said private portable terminals are adapted for being carried by passengers". Further, claim 1 recites that the system is "usable for distributing information and entertainment programs to the said portable terminals for use by the passengers". The references, even if combined, do not teach these limitations of claim 1.

The Examiner cites Wakai as teaching a vehicle entertainment system. However, Wakai does not suggest a private portable terminals which are adapted to be carried by passengers. Instead, Wakai teaches a system attached to the vehicle and not private or portable. The Examiner cites Croy as teaching a portable terminal. However, Croy merely teaches a device for monitoring and controlling electronic devices in the home (i.e., a remote control; see col. 1, lines 11-12 and col. 2, lines 16-17). The Croy device does not provide any entertainment function, and is not suggested for use in a vehicle. Thus, Croy cannot be combined with Wakai to obtain the invention, because the combination would not result in a *portable* terminal for distributing "distributing *information* and *entertainment* programs" to a passenger, as claimed (emphasis added).

The Examiner argues that Wakai teaches a "portable" system because a plane moves. This is a strained definition of the term "portable" and not consistent

with how the term is used in the application or by one skilled in the art. Merriam-Webster's online dictionary defines "portable" as "capable of being carried or moved about" which is not consistent with the Examiner's definition. Note that it is the *plane* which moves, not the *system* of Wakai, thus the entertainment system of Wakai, which is fixed to the aircraft, is *not* portable. However, the claim has been amended to recite that the terminal is adapted for being carried by a passenger to further define the term "portable" consistent with the specification.

Claim 1 further recites that "passengers' identification data" is stored in the portable terminals "in such a manner that these identification data are transmitted to said central data processing means, so that the said system can also be used for checking the passengers' travel authorizations". Neither reference suggests this element of claim 1. In response to prior arguments on this point, the Examiner states that "passenger travel authorization checking" is a "use limitation" and thus not given patentable weight. Applicant disputes this characterization of the limitation. Checking travel authorization is a *function* of the system, and thus is clearly a patentable limitation. See MPEP §2173.05(g).

The Examiner also claims that checking credit card authorizations is equivalent to the cited limitation, without backing up this conclusory statement. Applicant disputes that checking a "travel authorization" is equivalent to authorizing a credit card purchase. The processes likely use different data and different criteria. For example, travel authorization might require a valid passport. No such requirement is likely to exist for credit authorizations. The burden is on the Examiner to show equivalence, if any. A mere statement that it is so is not sufficient.

Further, the Examiner states that it is well-known in the security art to perform travel authorizations. Applicant fails to understand how, even if true, such a fact is relevant. Applicant is claiming a *system*, using private portable *terminals* adapted for being carried by *passengers*, for performing travel authorizations and also for providing entertainment and information. If this is well-known, then the Examiner can easily provide references to support this assertion. Mere assertions that this is so is not adequate to support a *prima facie* case of obviousness.

Because the references do not suggest this limitation either, claim 1 is

patentable over the references even if combined for this reason as well.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references without any proper motivation for the combination, which is what the Examiner is attempting to do.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

Claims 2-15, 17, 18, and 20, which depend, directly or indirectly, on claim 1, are thus patentable for at least the same reasons.

Claim 23, as amended, also recites "portable personal terminals" which are "adapted for being carried by the passengers" wherein "travel authorizations are transmitted to central data processing means over a data bus that is also used for distributing information and entertainment programs to the passengers". Thus, claim 23 is patentable over the references for the same reasons discussed for claim 1.

Claims 24-27 depend, directly or indirectly, upon claim 23, and thus are patentable over the references for the same reason as claim 23.

Claim 28, as amended, and new claim 30 recite similar limitations as claim 1, and thus are patentable for the same reasons. Claim 29 depends on claim 28, and thus is patentable for at least the same reasons.

Claims 16 and 19 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over Croy and Wakai, and further in view of French Publication (0465456 A1). For the following reasons, the rejection is respectfully traversed.

Claim 16 and 19 depend, directly or indirectly, on claim 1. The French publication does not overcome the shortcomings identified for claim 1, and thus claims 16 and 19 are patentable over the combination. Further, the Examiner has failed to provide the proper motivation for combining the references, and hence the rejection is improper.

Claims 21 and 22 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over Croy and Wakai, and further in view of Orlen (U.S. 5,579,535). For the following reasons, the rejection is respectfully traversed.

Claim 21 and 22 depend, directly or indirectly, on claim 1. Orlen does not overcome the shortcomings identified for claim 1, and thus claims 21 and 22 are patentable over the combination. Further, the Examiner has failed to provide the

proper motivation for combining the references, and hence the rejection is improper.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34183.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

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